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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,524	09/16/2003	Dean A. Schaefer	2024728-7031453001 (00-01)	4302
7590	05/17/2005		EXAMINER	
Bingham McCutchen, LLP Suite 1800 Three Embarcadero San Francisco, CA 94111-4067			PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/664,524

Applicant(s)

SCHAEFER ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-71 is/are rejected.
- 7) ☒ Claim(s) 51-52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/16/03</u> . | 6) <input type="checkbox"/> Other: _____  |

***Claim Objections***

The claims are objected to for the improper numbering of the claims. Applicant's preliminary amendment of December 15, 2003 added new claims 42-71. However, there were two claims numbered 52, and no claim number 51. Additionally, the second claim numbered 52 is dependent upon claim 52. The examiner has renumbered the first claim 52 as claim "51", and future correspondence from applicant should reflect such a change. The applicant is further required to correct the dependency of the second claim numbered "52", which will presumably be dependent on the first claim originally numbered "52" and now renumbered as claim "51".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42-44, 46, 47, 49-52, 54, 55, 57-62, 64-66, 68 and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards et al (5,370,675).

Edwards et al disclose an ablation probe comprising an elongated member (210 – Figure 16) having a plurality of elongated electrode tines (200) extending through the elongated member. The electrode tines are each provided with an electrical insulation (202) having a lumen through which the tines extend. The electrode tines extend through apertures (216) in the elongate member to conform to an outwardly everted configuration when extended, and may be retracted within the elongate member.

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Edwards et al provide various embodiments for an actuating mechanism to individually extend/retract the electrodes (see Figures 11, 12, 14, 18, 19 and 26). The electrode tines are needle electrodes (i.e. stylets) that penetrate tissue (see Figure 1), and the elongate member is a cannula that is provided into tissue. RF energy is provided to the electrodes, as well as various other energy types, whereby the energy source is configured to provide energy in cyclical patterns.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-44, 46-52, 54-62, 64-66 and 68-71 are rejected under 35 U.S.C.

103(a) as being unpatentable over Edwards et al (5,536,267) in view of the teaching of Edwards et al ('675).

Edwards et al ('267) disclose a device very much like the Edwards ('675) device. It includes an elongate, rigid probe (12) and a plurality of electrode tines (20) extending through the probe. The tines include an insulated tube (28 – Figure 8) through which the tines extend. The tines are extended to assume an everted profile when deployed, and may be withdrawn into the elongate member. The electrodes are needle electrodes for penetrating tissue, and are connected to an RF generator source. The RF generator source may provide energy to the tines in cyclical intervals via a control mechanism (see col. 11, lines 15-40). Edwards et al ('267) further disclose an actuating means to

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extend/retract the electrodes, but fails to specifically disclose a means to actuate the electrodes individually. Rather, the Edwards et al ('267) device extends/retracts the tines simultaneously.

The Edwards et al ('675) device has been previously addressed and is substantially identical to the Edwards et al ('267) system. In particular, Edwards et al ('675) teach that it is advantageous to provide the elongate member with a means to individually control the deployment of the electrode tines into tissue.

To have provided the Edwards et al ('267) device with a means to deploy the electrodes individually to control the number of electrodes in the tissue site would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Edwards et al ('675).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 42-71 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No.

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6,638,277. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claims and the patented claims are merely minor, obvious changes.

### ***Conclusion***

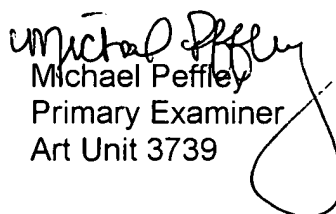
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gough et al (5,672,173) discloses another probe having deployable electrode tines for penetrating and treating tissue, and Eggers et al (5,766,153) disclose a multiple electrode system with a proximally located distributor device for controlling the delivery of energy to the individual electrodes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
May 12, 2005